



Express Mail No. EV 533 736 026 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Li-Huan Jen

Confirmation No.: 4631

Serial No.: 09/578,217

Art Unit: 2653

Filed: May 23, 2000

Examiner: Psitos, Aristotelis M.

For: *Apparatus and Method for Counting
Error Rates in an Optical Compact Disc
Storage System*

Attorney Docket No.: 60976-0014
(formerly 9826-0014-999)

January 12, 2005

RESPONSE TO FINAL OFFICE ACTION – FILED WITH RCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The enclosed Amendment is in response to the Office Action dated July 15, 2004 for the above identified patent application. This response is being filed with a Request for Continued Examination (RCE).

It is noted that a first response to the final office action was timely submitted on September 14, 2004, within two months of the final office action mailing date.

Petition for One or Two Month Extension of Time under 37 CFR 1.136. It is respectfully requested that the time for response to the Office Action dated July 15, 2003 be extended for a period of one (1) or two (2) months from **November 15, 2004** (4 months from the final office action date) or **December 27, 2004** (the date of the Advisory Action) to and including January 15, 2005. It is noted that the box (a) in the advisory action of December 27, 2004 was checked by mistake when it should have been the box (b) be checked since the response to the final rejection dated July 15, 2004 was submitted within the two-month callup period. However, if the Examiner was correct in checking box (a), then a Two Month Extension of time is respectfully requested. The fee for this extension is estimated to be either \$110 or \$420, depending on whether a one or two month extension is required.

The Commissioner is hereby authorized to charge any required fee(s) to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (order no. 60976-0014-US). A copy of this sheet is enclosed for such purpose.

Therefore, besides the deficiencies associated with each of the references, there does not exist sufficient motivation and reasonable expectation of success for one skilled in the art to combine the teachings of the four references. A combination of the cited references will definitely not result in a method or apparatus that not only detects errors in data reproduced from an optical disk, but also makes non-trivial proactive adjustments to system parameters so as to reduce the number of future errors of the system.

Since the cited references fail to teach or suggest key features (e.g., **comparing the error rate with a threshold value and initiating first and second remedial actions** in accordance with the comparison result) recited in claim 10, claim 10 its dependent claims 11-16 and 25-26 are patentable over the references cited by the Examiner.

Claims 1, 8 and 18 are three apparatus claims, each of which recites a comparator for comparing the average error rate with a predefined threshold rate value and initiating different remedial actions in accordance with different comparison results. Therefore, claims 1, 8 and 18 and their respective dependent claims 2-6, 21-22, 23-24, 19, 27-29 are also patentable over the cited references for at least the same reasons discussed above.

In light of the above amendments and remarks, Applicant respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (650) 843-7501, if a telephone call could help resolve any remaining items.

Respectfully submitted,

Date: January 12, 2005



Gary S. Williams

MORGAN, LEWIS & BOCKIUS LLP

2 Palo Alto Square, Suite 700

3000 El Camino Real

Palo Alto, California 94306

(650) 843-4000

31,066

(Reg. No.)